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08/473789

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/473,789	06/07/95	CURTISS	R MEGAN-100-21
			EXAMINER
PATREA L PABST ARNALL GOLDEN & GREGORY 2800 ONE ATLANTIC CENTER 1201 W PEACHTREE STREET ATLANTA GA 30309-3450			RYAN, V PAPER NUMBER 30 1641 DATE MAILED: 01/21/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 9/20/99

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-16, 20-32, 35-38, 41-45 is/are pending in the application.
Of the above, claim(s) 5-9, 13, 21, 22, 25, 26, 36, 38 is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 1-4, 8-14, 16, 20, 23, 24, 27-32, 35, 37, 41-44 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The Examiner acknowledges receipt of the amendment filed September 20, 1999.

In this application:

Claims 17-19, 39 and 40 were canceled.

Claims 1, 3, 23, 27, 29, 30 and 35 were amended.

Claims 41-45 were added.

Claims 1-16, 20-32, 35-38 and 41-45 are now pending.

Claims 1-4, 8-14, 16, 20, 23, 24, 27-32, 35, 37 and 41-45 are now under examination.

Response to Amendment

(1) The rejection of claims 1-4, 8, 10-14, 16, 20, 23, 24, 27-29, 30-32, 35 and 37 under 35 U.S.C. 102(e) as being anticipated by Molin et al is withdrawn.

(2) The rejection of claims 3, 23, 24, 29-32 and 35 under 35 U.S.C. 112, first paragraph is withdrawn.

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(3) The rejection of claims 1-3, 10-12, 23, 27 and 28 under 35 U.S.C. 102(b) as being anticipated by Gerdes et al (Proc. Natl. Acad. Sci.) is withdrawn.

(4) The rejection of claims 1-3, 10-12, 27, 28 and 37 under 35 U.S.C. 102(b) as being anticipated by Gerdes et al (EMBO Journal) is withdrawn.

(5) The rejection of claims 39 and 40 under 35 U.S.C. 112, first paragraph is considered moot in view of the cancellation of the claims.

The following are new grounds of rejections:

Claim Rejections - 35 USC § 112

Claims 1-4, 8-14, 16, 20, 23, 24, 27-32, 35, 37 and 41-44 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Applicant refers to page 10, lines 6-10 and asserts that the specification teaches the use of a copy of a host gene inactivated in the host cell as the essential gene.

However, the specification teaches host cell which are regulated to allow expression of essential and replication genes only in a permissive environment and expression of the lethal genes in non-permissive environments. Furthermore, the specification teaches the host cell has "an inactivated native gene encoding a gene essential for cell survival."

Claims 1-4, 8-14, 16, 20, 23, 24, 27-32, 35, 37 and 41-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 27, 29 and 30 are indefinite in the recitation of "the essential gene corresponds to an inactivated native gene of the cell". It is not clear if Applicant intends an inactivated native gene encoding an essential gene or an inactivated native gene as well as an essential gene or an inactivated essential gene.

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Claim 43 is indefinite for being in improper Markush format. The use of the phrase "selected from the group consisting of..." is recommended.

Claim 42 is indefinite in the recitation of "the essential." It is recommended that the claim should be amended to recite "the essential gene is a gene essential."

The Group and/or Art Unit location of your application in the Patent and Trademark Office may have changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1641.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to V. Ryan whose telephone number is (703)305-6558.

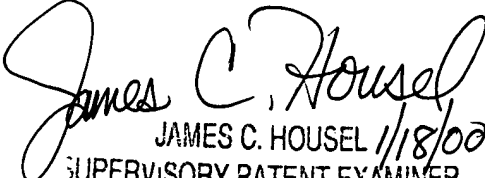
Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0196.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027.

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Papers related to this application may be submitted to the Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax number for Art Unit 1641 is (703) 308-4242.

V. Ryan
Patent Examiner/Art Unit 1641
January 2000
Ryan/vr


JAMES C. HOUSEL 1/18/00
SUPERVISORY PATENT EXAMINER